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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,262	10/16/2001	Brendan Nolan	P67232US0	2262

7590

10/07/2005

LAW OFFICES OF JACOBSON HOLMAN
PROFESSIONAL LIMITED LIABILITY COMPANY
400 SEVENTH STREET, N.W.
WASHINGTON, DC 20004

EXAMINER

TIV, BACKHEAN

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/977,262	Applicant(s) NOLAN ET AL.	
	Examiner Backhean Tiv	Art Unit 2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/02</u> . | 6) <input type="checkbox"/> Other: _____ |

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Detailed Action

Claims 1-89 are pending in this application.

Information Disclosure Statement

The IDS filed on 1/9/02 have been considered.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in EPO on 10/16/01. It is noted, however, that applicant has not filed a certified copy of the EPO 00650155.5 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 82-89 is not limited to tangible embodiments. In view of Applicant's disclosure, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments and intangible embodiments. As such, the clam is not limited to statutory subject matter is therefore non-statuory.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 60 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 60 recites, "at Xr-2p-e-2p" it is unclear of what is being claimed.

Claim Objections

Applicant is advised that should claim 16 be found allowable, claim 20 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-89 rejected under 35 U.S.C. 102(e) as being anticipated by US

Publication 2002/0052922 issued to Matsuura et al.(Matsuura) .

As per claim 1, 45,67,76, Matsuura teaches a method in an email processing assembly having a mail server, processors, processor engines for processing an email into formats suitable for the recipient and storage means associated therewith for the distribution of an email to an intended recipient in a predetermined format suitable for the recipient(Abstract, paragraph 0079), the email having a message and an initial header comprising email data comprising: routing data including originating data(Fig.23), address data identifying the intended recipient(Fig.23); constituent data indicating the nature of the email(Fig.23; subject); and content data comprising reference to the components of the email message itself, the email being received in a mail server in which the following steps were carried out(paragraph, 0124); prior to receiving the email to prepare the processing assembly to carry out the method: preparing a classification database (Fig.11,)comprising: a plurality of classifications of emails having regard to their attributes(paragraph 0067,0068); and at least one processing operation with suitable processing instructions associated therewith allocated to each classification to provide a classification instruction list for routing the email through the processing engines(paragraph 0067,0071, 0079); storing in the instruction list database the instructions necessary to perform the processing from one format to another format(paragraph 0069-0071); storing in a recipients database the formats suitable for each recipient as recipients processing requirements(paragraph 0067); storing in a management rules database data specifying the manner in which the email will be processed and distributed and comprising, on an email being received(paragraph 0053):the email is accepted from the mail server(Fig.2), the email is

copied to a mail store memory(Fig.2); the email is immediately transmitted in accordance with the initial header(Fig.23; paragraph 0016); retrieving the initial header(0053, Figs.12, 13,23), searching the management rules database(0053, Figs.12, 13,23); retrieving appropriate rules having regard to the initial header(paragraph 0061); adding the rules to the initial header to form a system header(paragraph 0067,0068); retrieving the processing requirements for the recipients from the recipients database(paragraph 0083); adding the recipients processing requirements to the system header, retrieving the stored email from the mail store memory(paragraph 0017); carrying out any necessary processing of the email having regard to the system header by retrieving the instructions from the instructions list database(paragraph 0062, 0067); and distributing the email in accordance with the system header including substituting the email where necessary for the originally distributed email(paragraph 0079).

As per claim 2, 41,53, in which initially there is provided: a classification database comprising a plurality of classifications of emails having regard to their attributes(paragraph 0057, 0061); and at least one processing route with suitable processing instructions associated therewith allocated to each classification to provide a classification instruction list(paragraph 0079).

As per claim 3,17,59,68, in which on receiving the email, the email is classified having regard to those attributes which can be ascertained from the header and the email message itself and the classification is added to the system header to control the

manner in which the necessary processing requirements are carried out(paragraph 0067).

As per claim 4,18,21,32,39,50,60,69,in which on receiving an email, the email is classified having regard to those attributes which can be ascertained from the header and the email message itself and if the full attributes of the email cannot be ascertained(paragraph 0053), an interim classification is allocated to identify the necessary processing requirements to ascertain the attributes of the email(paragraph 0053, 0057), the interim classification is added to the system header, the necessary processing is carried out having regard to the interim classification(paragraph 0060, 0079), the email is reclassified having regard to the attributes which can now be ascertained from the header and the email and the new classification is added to provide the system header and thus those necessary processing requirements(paragraph 0054).

As per claim 5,19,48,61,70, in which on receiving an email, the email is classified having regard to those attributes which can be ascertained from the header and the small message itself and if the full attributes of the email cannot be ascertained to provide a full system header(paragraph 0053) : an interim classification is allocated to identify the necessary processing requirements to ascertain the attributes of the email(paragraph 0053,0057); the interim classification is added to the system header, the necessary processing is carried out having regard to the interim classification(paragraph 0060,0079); the email is re-classified having regard to the

attributes which can now be ascertained from the header and the email, the classification is added to the initial header, and the management rules database is then searched until the system header is provided (paragraph 0054).

As per claim 6, 16, 20, 31, 40, 49, in which on an email being received: the email is accepted from the mail server (Fig. 2); the email is copied to a mail store memory (Fig. 2); the email is immediately transmitted in accordance with the header (Fig. 2); the method is carried out by retrieving the stored email from the mail store memory and the email is distributed in accordance with the method including substituting, where necessary, this email for the original email transmitted (Fig. 2, paragraph 0057).

As per claim 7, 22, 33, 42, 51, 62, 71, 79 comprising: accepting the email from the mail server in a mail store memory (Fig. 2); allocating the system header, storing the email message with the system header in at least one unique location in a mail store database and then carrying out any necessary processing of the email, reading the system header (Fig. 2); retrieving the appropriate instruction from the classification database (paragraph 0060-0061); sending an instruction to carry out the operation on the message (paragraph 0064); retrieving the message from the mail store database (Fig. 2, paragraph 0058); carrying out the operation on the message (paragraph 0064); entering a record of the completion of the instruction in the header to provide a revised system header (paragraph 0058,); storing the email in the mail store (Fig. 2, paragraph 0058); and reading the revised system header and if the email is suitable for

sending to the intended recipient, transmitting fine email in accordance with the routing data in the system header(paragraph 0058, 0068-0073).

As per claim 8,34,43,53,63,72, in which the classification is chosen from one or more of: single recipient with no attachment, single recipient with multiple attachments, single recipient with compressed attachments, single recipient with encrypted attachments, multiple recipients with no attachments, multiple recipients with multiple attachments, multiple recipients with compressed attachments, multiple recipients with encrypted attachments, the size of the email message, the size of any attachments, known encryption algorithm; externally originating email(Fig.23); internally originating email, and urgency marking.

As per claim 9,23,35,44,54,65,74, in which when the classification allocated to an email requires the carrying out of more than one instruction, the instructions are carried out in a predetermined order, the system header being updated each time an instruction is carried out to provide a new system header(paragraph 0016).

As per claim 10,24,30,36,45,55,66,75, in which, can carrying out the instruction or the last of the instructions, the email is not suitable for sending: the header is read again(paragraph 0019); a new classification is a located to the email(paragraph 0019); a new system header is prepared from the new classification and the routing data(paragraph 0019); and then the operations required by the new system header are carried out(paragraph 0019).

As per claim 11,25,37,46,52,56,78, in which, on retrieving the instruction from the classification instruction list the instruction is stored in a processors routing database as

a queue for a processor engine chosen to carry out the operation in response to the instruction(paragraph 0083); the processor engine accesses the instruction(paragraph 0060); the message is retrieved from the mail store database(Fig.2); the processor engine carries out the operation on the message(paragraph 0065); and the revised system header is returned to the routing database for further routing of the email(paragraph 0071).

As per claim 12,26 in which the preparation of the system header includes allocating a priority to the email(Fig.22).

As per claim 13,27, in which, on an instruction requiring a specific operation to be carried out for which there is more than one processor or more than a number of processors capable of carrying out the instruction, the header is read and optimum choice of the processors is made(Fig.24).

As per claim 14, 28,38,47,57,64,73,81 in which: there is provided a processor resource database in which is contained all the processor engines for carrying out a particular instruction listed singly and in combination as individual processor engines(paragraph 0068-0071); a system resource usage is listed for each processor engine(paragraph 0068-0071); a processing time for the instruction to be carried out is listed for each processor engine(paragraph 0068-0071); and on an instruction requiring a specific operation to be carried out for which there is more than one processor engine or more than a number of processor engines capable of carrying out the instruction, the header is read and optimum choice of the processors is made(paragraph 0068-0071).

As per claim 15,29, in which in transmitting the email, the identifier of the sender is stored together with the instructions carried out for transmittal between sender and recipient and on the subsequent sending of an email to the original sender, the instructions are retrieved and used to reformat the outgoing email for ease of receipt by the original sender(paragraph 0053,0057).

As per claim 77, in which the mail store memory comprises a separate store having a unique location for each attachment(Fig.1-2).

As per claim 80, in which the processor comprises a processor operated by a third party and the router includes means to establish a communications link with the processor(Fig.1-2, paragraph 0053).

As per claim 82-89, a computer program comprising program instructions for causing one or more computers carry out the method as claimed in claim 1,2,16,30,39,48,58,67(Fig.1-2).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

US 5,848,415 issued to Guck

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Backhean Tiv whose telephone number is (571)272-3941. The examiner can normally be reached on 9 A.M.-12 P.M. and 1 -6 P.M. Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BT

Backhean Tiv
2151
9/30/05



ZARNI MAUNG
SUPERVISORY PATENT EXAMINER